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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,908	07/09/2001	Ing-Jing Huang	P60998US0	8599
136	7590	09/26/2003		
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			EXAMINER [REDACTED]	VO, HAI
			ART UNIT [REDACTED]	PAPER NUMBER 1771

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/868,908	HUANG, ING-JING	
	<b>Examiner</b>	<b>Art Unit</b>	
	Hai Vo	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 July 2003.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3 and 7-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 and 7-48 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 7, 8, 10, 11, 25, 26, 28, 29, 31, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Selner (US 4,187,620) as substantially as set forth in the Office Action mailed on 04/18/2003. Selner teaches a three dimensional air cushion for use in a shoe comprising one air chamber 24 having a sealed periphery edge 40, a base portion 38 and two opposed lateral sides located on opposite sides of the base portion to form a concave structure. Selner discloses the two opposed lateral sides projecting above a plane occupied by the base portion to form elevated sidewalls of the air cushion and forming a U-shape with the base portion (figures 3 and 4). Selner also teaches the shoe bottom that includes an air chamber 24 being fitted in a lining (column 2, lines 47-48) and a pair of mating platform members 30 and 32 (figure 1, column 2, lines 63-64). Likewise, it is apparent that the base portion and the two lateral sides being formed between a lining and the platform members. Figures 3 and 4 show that an inner surface area of

the air cushion defined by the lining and inner sole 26 being smaller than an outer surface area of the air cushion defined by the platform members. The air cushion further includes a one-way valve 44 and an associated inlet for filling air. It is the examiner's position that Selner anticipates the claimed subject matter.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Selner (US 4,187,620) as applied to claims 1 and 2 above, further in view of Grim (US 5,353,525) as substantially as set forth in the Office Action mailed on 04/18/2003.
5. Claims 37, 38, 40, 41, 43, 44, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Selner (US 4,187,620) as applied to claims 1 and 2 above, further in view of Huang (US 4,670,995) as substantially as set forth in the Office Action mailed on 04/18/2003.
6. Claims 3, 9, 12-24, 27, 30, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Selner (US 4,187,620) in view of Donzis (US 4,217,705) as substantially as set forth in the Office Action mailed on 04/18/2003.

7. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Selner (US 4,187,620) in view of Donzis (US 4,217,705) as applied to claim 3 above, further in view of Grim (US 5,353,525) as substantially as set forth in the Office Action mailed on 04/18/2003.
8. Claims 39, 42, 45, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Selner (US 4,187,620) in view of Donzis (US 4,217,705) as applied to claim 3 above, further in view of Huang (US 4,670,995) as substantially as set forth in the Office Action mailed on 04/18/2003.

***Response to Arguments***

9. The claim objections with respect to claims 40-45 have been overcome by the present amendment.
10. The art rejections in the Office Action mailed on 04/18/2003 have been maintained for the following reasons. The arguments that Selner fails to disclose an air cushion structure are not found persuasive for patentability. Selner teaches a three dimensional air cushion for use in a shoe comprising one air chamber 24 having a sealed periphery edge 40, a base portion 38 and two opposed lateral sides located on opposite sides of the base portion to form a concave structure. Selner discloses the two opposed lateral sides projecting above a plane occupied by the base portion to form elevated sidewalls of the air cushion and forming a U-shape with the base portion (figure 4). Figure 4 also shows that an upper surface 38 and a lower surface bounding a platform 20. The examiner absolutely agrees that the platform 20 of Selner is a pad, not an air cushion structure. However, the heel cup structure of

Selner is the one that corresponds to the claimed air cushion structure, not a platform 20 as argued by Applicant. Further, Applicant argues that the Selner is composed of a film made cushion without teaching the concept of a three-dimensional structure air cushion. The arguments are not found persuasive. Figure 2 shows that the heel cup 24 has a three dimensional structure. Selner does not specifically disclose an air cushion providing the function of distributing shock forces delivered to the sidewall. However, since the heel cup of Selner meets all the structural limitations required by the claims, it is not seen that the base portion of the heel cup would have performed differently from that of Applicant's air cushion. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete (Note discussion found in Ex parte Slob, 157 USPQ 172). For these reasons, the art rejections are therefore sustained.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5,669,161 related to a shock absorbing cushion structure that are formed by upper and lower sheets peripherally sealed and formed to define a series of intercommunicating air chambers therebetween.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on M,T,Th, F, 8:30-6:00 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV

  
TERREL MORRIS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700